

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of : Richard Douglas Kemp
Application No. : 10/603,207
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Art Unit : 2681
Title : Electronic Management and Distribution of Legal Information
Attorney Docket No. : 336001-2024.1

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REPLY BRIEF

ARGUMENT

In the Examiner's Answer of 14 October 2011 (the "Answer"), the examiner attempts to defend the rejections of all claims as anticipated by U.S. Patent Application Publication 2006/0253449 by Williamson *et al.* (Answer at 4.) As shown at length in the applicant's Appeal Brief of 22 August 2011 (the "Brief"), however, Williamson fails to teach or suggest all limitations of any claim. And the Answer merely emphasizes the rejections' reliance on incorrect and improper readings of the claims and cited prior art.

The Federal Circuit has emphasized that, to anticipate any claim, the prior art reference must clearly and unequivocally disclose the claimed invention without any need for picking, choosing, and combining various disclosures, even disclosures in a single reference, if the disclosures are not directly related to each other by the teachings of the cited reference. *See Net MoneyIN, Inc. v. Verisign, Inc.*, 545 F.3d 1359, 1371, 88 U.S.P.Q.2d 1751, 1760 (Fed. Cir. 2008). The *Net MoneyIN* decision is unambiguous on this point:

We thus hold that unless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.

Id. at 1371, 88 U.S.P.Q.2d at 1759.

Therefore, to anticipate claim 1, Williamson must teach "items of legal information" that satisfy all the limitations of claim 1. As discussed on pages 7–8 of the Brief, the claimed items of legal information have the following properties:

- they are responsive to the request;
- they are associated with content;
- they are each associated with respective topic tags that identify legal topics or subtopics that are associated with the items; and
- they are each associated with respective type tags that identify types of legal information corresponding to the associated items.

As provided for display, the items of legal information are:

- automatically tabulated by the respective type tags; and
- configured to be selectable at the user terminal to provide a request for display of the associated content.

In the Answer, as previously, the examiner yet again fails to identify what specific disclosure in Williamson is supposed to correspond to the claimed items of legal information that include these limitations. Rather, the examiner simply asserts that Fig. 4 of Williamson teaches a user interface that includes a table comprising a plurality of items of legal information. (Answer at 17.) The examiner ignores the applicant's showing in the Brief that nothing in the cited Fig. 4 satisfies the limitations applicable to the claimed items of legal information. (Brief at 9.)

Indeed, the examiner's own arguments are inconsistent with finding the claimed items of legal information in Fig. 4. For example, the examiner quotes Williamson at paragraph 0054, where Williamson writes that the leftmost pane of the displayed window presents a topic listing that is divided into general topics and specific topics. (Answer at 19.) The examiner then asserts that "Fig. 4 show[s] a clause selection module 60 displayed in a table, which allows a user to select a clause to be displayed on the clause panel 65." (*Id.*)

The displayed clause therefore seems to be in the examiner's view the claimed "associated content" that is requested for display. If that is the case, though, then Fig. 4 displays only "topics"—one of which may be selected to bring up the clause—and "content". Nothing remains in Fig. 4 to be the claimed "items of legal information."

The examiner ignores yet other limitations in rejecting claims 7–9, 62, and 66–67, reading "automatically" and "responsive to the request" out of the claims. For example, claim 7 claims "automatically access[ing] . . . new legal information responsive to the request," where the antecedent basis in claim 1 for "the request" is a request received from a user terminal, in response to which the plurality of legal items are accessed in the database or databases. In connection with this limitation, the examiner writes: "[N]ew legal information (i.e., "annotation") can be requested by clicking on the hyperlink

associated with the legal information displayed on the display device as claimed. Williamson's Fig. 4 shows two hyperlinks 74a and 74b which allow [the] user to request [a] new annotation while the legal information is displayed." (Answer at 21.)

The examiner thus asserts in the Answer that a limitation of *automatically* retrieving information responsive to a *previous* request is met by retrieving information responsive to a *new* request, a request that the user has entered *manually*. And aside from the manifest incorrectness of reading claim terms to mean their exact opposites, the examiner's interpretation cannot be reconciled with claim 8, which claims "automatically and periodically" updating the search, or claim 9, which claims "automatically and continuously" updating it.

The examiner's arguments with respect to claims 30 and 34–35 similarly ignore claim terms and claimed distinctions. For example, claim 30 claims, among other things, formatting documents according to a protocol and storing the formatted documents in at least one database. In connection with this claim, the examiner writes that "Williamson teaches at [0039] that the legal documents are formatted using [a] tag-delimited language such as HTML or XML." (Answer at 21) But the cited paragraph of Williamson discusses Web pages, not the clauses in the library. (§ 0039.) And the applicant has shown that marking up a document in HTML or XML is not formatting documents according to a protocol (Brief at 14–15)—and the examiner has not even tried to rebut that showing.

Finally, in rejecting claims 10–12 and 32–33, the examiner incorrectly interprets "database". The examiner writes:

Williamson teaches at [0042] that "the database 19 is relationally organized into a logical set of tables, lists, and indices which are related through table links. There are four logical tables: clause table 40, outline table 41, annotation 42 and learn topics 44." Williamson therefore teaches a plurality of databases (i.e. "logical tables") for separately storing different type of legal information (i.e. "clause", "outline", "annotation").

(Answer at 22.)

Thus, in the examiner's view, "database" does not mean "database". It means "table". The examiner seems not to see any requirement even that tables be actually separate to be treated as separate databases, so long as they are "logically" separate. And more: storing clauses, outlines, and annotations in separate logical tables seems to constitute storing them in different "databases" *by legal topic*, which is what claim 10 claims.

In sum, the rejections depend on taking "automatic" to mean "manual", "separate databases" to mean "one database", and "database field" to mean "web page" and further on taking other, significant claim limitations to mean nothing at all. But however broadly claim terms are to be interpreted, they cannot so be taken to mean their exact opposites or interpreted out of existence. And without these impermissible readings of the claims and the prior art, the rejections cannot be sustained.

For the foregoing reasons and those set forth in the Brief, the applicants respectfully submit that all pending claims are allowable over the cited prior art, and that the Examiner's Answer fails to establish otherwise. The Board is therefore respectfully asked to reverse all rejections and allow the claims.

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Respectfully submitted,

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